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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,469	02/22/2002	Rajesh Patanaik	2083.000300/P6121	8471

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT PAPER NUMBER

3627

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/080,469

Applicant(s)

PATANAIK ET AL.

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims lack a nexus to the technological arts (e.g., claiming the steps performed via a computer.)

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 is indefinite because "item" lacks antecedent basis.

Claim 15 is indefinite because it is not clear what is meant by tracking the usage of a resource "based on" determining that the resource is for resale.

Claim 17 is unclear, because it appears that no means for receiving is discussed in the specification. While receiving the item is discussed, no apparatus appears to be contemplated for performing the receiving.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 6, 7, 9-11, 17, 18-21, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by DeBusk et al (6,314,556).

DeBusk et al show placing a request order for an item, comprising scheduling an event and allocating an item to that event via the reservation system; receiving the item for use during the event; providing an indication of receipt of the item, comprising moving the item from the first location to a second location and having the asset location system acknowledge the movement; and reducing the inventory associated with the first location in response to the receiving and moving the asset (the system reduces the inventory upon the act of moving the item from the first location).

As to claims 3 and 4, DeBusk et al show placing the request from the second location.

As to claim 6, DeBusk et al show the item being designated as rotational equipment since it shows the same equipment being used by different users at different times.

As to claim 7, DeBusk et al show tracking use of the item.

As to claims 9, and 11, DeBusk et al show an article comprising a computer system comprising one or more storage medium having instructions that when executed enable a processor to provide an order to acquire a resource from a source, (the scheduling, allocating and reserving software); to provide an indication based on receiving the resource (e.g., the software detecting movement of the item); and to reduce the number of resources based on the indication.

As to claim 10, DeBusk et al show providing the order from a first center comprising a first location to a second center comprising a second location.

As to claim 17, DeBusk et al show means for placing a request order comprising a computer and software as discussed above; means for receiving the item; means for providing an indication of receipt of the item comprising the sensors and associated software for noting movement of equipment; and means for reducing inventory associated with the first location in response to the indication.

As to claim 18, it is noted that DeBusk et al show all elements of the claim as previously discussed above. It is noted that in claims 18-26, the "adapted to" language is interpreted as intended use, as are all claims which only further expand on the intended use recited in claim 18. However, in order to promote compact prosecution, the claims are additionally treated below as if the language provided further limitations.

As to claims 19-21 and 23, it is noted that DeBusk et al show all elements.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBusk et al in view of Conway (5,732,401).

As to claim 14, DeBusk et al show all elements except determining if the resource is designate for resale to a customer. Conway shows this element. In Conway, the tracking system tracks expendable supplies in addition to assets of the business. It is noted that upon their use, the expendable supplies are charged to the customer. It would have been obvious to one of ordinary skill in the art to modify the software of DeBusk et al by providing designation of items for resale to the customer in order to determine how to account for their cost.

As to claim 15, it is noted that DeBusk et al in view of Conway show tracking the usage of the resource based on determining that the resource designated for resale.

Claims 5, 12, 22 and 26 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DeBusk et al.

DeBusk et al show scheduling an item. The system can inherently perform the scheduling for any reason, including a benchmark test.

Alternatively, DeBusk et al show scheduling the item. It does not explicitly show that it is for a benchmark request. However, it is notoriously old and well known in the art to schedule an item for a benchmark test (e.g., scheduling an item for use in a medical test in which a health benchmark is determined). It would have been obvious to one of ordinary skill in the art to modify the method and software of Debusk et al by providing for such scheduling in order to streamline and track resources associated with medical tests.

As to claim 26, it is noted that DeBusk et al show all other elements of the claim.

Claims 2, 8, 13, 16, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBusk et al.

As to claims 2, 13 and 24, DeBusk et al show all elements of the claims except that the indication of receipt of the item includes an email message. However, it is notoriously old and well known in the art to send an email message to verify the receipt of an item. It would have been obvious to one of ordinary skill in the art to provide such an email in order to provide an indication of who has custody of the item.

As to claims 8, 16 and 25, DeBusk et al show all elements of the claims except that the order request is approved before it is sent. However, it is notoriously old and well known in the art to provide for approval for a request, especially in a medical environment where access to items may be controlled. It would have been obvious to one of ordinary skill in the art to modify the method of DeBusk et al by providing for

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approval of requests in order to provide for managerial control over costs associated with the use of assets and supplies.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven B. McAllister

STEVE B. MCALLISTER  
PRIMARY EXAMINER